

Serial No. 09/889,341  
Attorney Docket No. 6386-08-IMREMARKSI. Status of the Application

This paper responds to a non-final Office action mailed on October 29, 2004. The Application was filed with 5 claims. In a response to a Restriction Requirement, Applicant canceled claims 1 and 2 without prejudice or disclaimer, amended claims 3 through 5, and added new claims 6-8. The present paper cancels claims 3-8 without prejudice or disclaimer, and adds new claims 9-13. Therefore, claims 9-13 are currently pending in the present application. Applicant respectfully requests entry of the amendment and examination on the merits.

By action taken here, Applicant in no way intends to surrender any range of equivalents beyond that needed to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves all such equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art.

II. New Claims 9-13

Applicant has added new independent claim 9, which is similar to claims 6 (canceled) but does not include un-elected subject matter. New claims 10-13, which depend on claim 9, correspond to claims 3-5 and 8 of the prior paper. All of these claims are fully supported in the specification and therefore do not represent new matter.

III Rejection of Claims Under 35 U.S.C. § 103(a)

The Office action rejected claims 3-8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,977,361 to Hartwig et al. According to the Office action:

The difference between the instant process and Hartwig et al.'s is that the reaction conditions is different. The reaction temperature of Hartwig et al. is in the range of 100-120°C and in the presence of a catalyst, while the reaction temperature of instant processes is between room temperature and about 80°C.

The Office action further contends that one of ordinary skill in the art "would be motivated to employ the teaching of Hartwig et al. to obtain a process of preparing a compound of formula I" since the "optimization of variables, such as pH and temperature, in a known process (i.e., Hartwig et al.) is prima facie obvious."

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Applicant respectfully submits that Hartwig et al., as applied to new claims 9-13, does not render the claimed invention obvious, but instead teaches away from the claimed invention. Indeed, Hartwig et al. teaches that, for adequate yields, the preparation of N-aryl azoles requires relatively high temperatures (100°C or greater) and a transition metal catalyst. In contrast, and as noted in the Examples, the process recited in claims 9-13 of the present application, produces compounds of general formula I in good yield at relatively modest temperatures (from about RT to about 80°C). Moreover, the good yields are obtained in the absence of a transition metal catalyst. This is a surprising and unexpected result since one of ordinary skill in the art would expect that the reaction yield would decrease at lower reaction temperatures, especially in the absence of a catalyst.

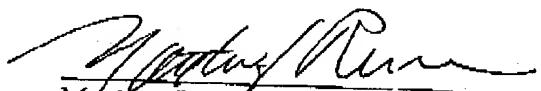
IV. Conclusion

In view of the foregoing, Applicant respectfully submits that all pending claims are patentable. If the Examiner has any questions, Applicant requests that the Examiner telephone the undersigned.

Applicant believes that no fees are required to file the present amendment. However, if any fees are required in connection with the filing of this amendment, please charge deposit account number 23-0455.

Respectfully submitted,

Date: January 29, 2003

  
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